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Docket No. GJE-7316
Serial No. 10/533,526Remarks

Claims 1-16 and 18-29 were pending in the subject application. By this Amendment, claims 1, 2, 11, 16, 18 and 22 have been amended and claims 4, 20 and 29 have been cancelled. Support for the amendments to the claims can be found throughout the specification and claims as originally filed. For example, support for the recitation of "substantially visible light-transparent" can be found at, for example, page 3 lines 4-5 and page 5 lines 14-15. Support for the description of the amines can be found at, for example, page 3 lines 13-17 and original claim 4. No new matter has been added by these amendments. Accordingly, claims 1-3, 5-16 and 18, 19 and 21-28 are before the Examiner for consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. The amendments should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 18 and 22 have been rejected under 35 U.S.C. §112, second paragraph. Claim 18 has been amended to depend from claim 16 and claim 22 has been amended to remove the narrow limitation. The applicant appreciates the Examiner's careful review of the claims. Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested in view of the amendments to the claims.

Claims 1, 3-6, 18 and 27-29 have been rejected under 35 U.S.C. §102(b) as being anticipated by Inoue *et al.* ('212) or Inoue *et al.* ('409). The applicant respectfully traverses this ground for rejection because the cited references do not disclose or suggest the specific materials and methods now claimed.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH*

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Equip. S.A. v. USITC, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In the current case, the cited references do not disclose the particular compounds recited in the applicant's claims. Note, for example, paragraph 6 of the International Preliminary Examination Report (IPER) wherein it is stated that:

None of D1, D2, D4 or D5 disclose a process in which the amine is a secondary or tertiary alkylamine in which each alkyl group has up to 12 carbon atoms and the amine has up to 24 carbon atoms, therefore subject-matter of the present claim 4 is novel.

Please note that the limitations of claim 4 have now been added to claim 1, and that D1 and D5 of the IPER are the Inoue *et al.* references listed in the current rejection.

Because the cited references do not disclose the compounds recited in the current claims, these claims cannot be said to be anticipated. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) based on Inoue *et al.* '212 and/or Inoue *et al.* '409.

Claims 1, 5-7, 11-16, 18, 27 and 28 have been rejected under 35 U.S.C. §102(b) as being anticipated by Bredoux *et al.* Again, the applicant respectfully traverses this ground for rejection because the Bredoux *et al.* reference does not disclose the particular compounds recited in the amended claims.

In this regard, note that this rejection was not applied to claim 4 and, as noted above, the limitations of claim 4 have been added to claim 1. Analogous amendments have been made to the other independent claims.

Because the cited reference does not disclose the compounds recited in the current claims, these claims cannot be said to be anticipated. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) based on the Bredoux *et al.* reference.

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Claims 2 and 19-26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Inoue *et al.* ('212) or Inoue *et al.* ('409) both in view of Bredoux *et al.* The applicant respectfully traverses this ground for rejection because the cited references, either alone or in combination, do not disclose the applicant's methods or coated substrates as now claimed.

The shortcomings of the Inoue *et al.* references have been discussed above. The Bredoux *et al.* reference does not cure these deficiencies. Specifically, the cited art does not suggest that a continuous substantially visible light-transparent layer could be provided on a support, the coating layer being markable and the two layers being compatible. This has been achieved because it has been appreciated that certain compounds, as recited in the applicant's claims, are soluble in organic solvents and compatible with film-forming solvent-soluble organic binders.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, none of the cited references contain a suggestion of the current invention. It is only the applicant's disclosure that provides such a teaching, and the applicant's disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Sponnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The Court of Customs and Patent Appeals was faced with an analogous situation in *In re Hayashibara and Sugimoto*, 188 USPQ 4 (CCPA 1975). The PTO Board of Appeals had affirmed a §103 rejection, and the CCPA reversed, stating:

Turning to the . . . rejection . . . for obviousness under 103, we agree with appellants that there is nothing in the reference which would lead those of ordinary skill in the art to employ [the substance] as appellants do in the product of claim 11. The reference does not teach [the substance] as possessing any of the characteristics or functions upon which appellants' claimed invention depends (emphasis added).

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The two Inoue *et al.* references (which are largely equivalent) make no suggestion of the claimed invention. As explained on page 2 of the present specification, Inoue *et al.* '409 describes how isopropylammonium molybdate is provided in "solution." An amide molybdate at pH2 precipitates out of solution, although polyvinyl alcohol acts as a complexing agent. This technology is neither as elegant nor as effective, as the use of a simple organic solution of an amine molybdate.

The two Inoue *et al.* references each disclose a process that involves two exposure steps, the first an imagewise exposure to UV radiation, and a transparent film on the sensitive layer. The present invention requires only one exposure step with laser IR radiation, and does not require a transparent film on the sensitive layer.

The importance of the transparency is that a coated substrate of the invention can be applied to, say, packaging already carrying markings, e.g., in the form of advertising or information about the contents, without affecting its legibility. Imagewise exposure of the coating then allows a contrasting pattern or specific mark, e.g., a barcode, to be applied, as desired.

It is well established in the patent law that in order to support a *prima facie* case of obviousness, a person of ordinary skill in the art must find both the suggestion of the claimed invention, and a reasonable expectation of success in making that invention, solely in light of the teachings of the prior art. *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). The applicant respectfully submits that the teachings of the Inoue *et al.* reference, even in combination with Bredoux *et al.*, fail to provide a *prima facie* basis for obvious for the above reasons. These references, taken alone or in combination fail to disclose or suggest the methods and compositions of the subject invention. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103 based on the two Inoue *et al.* references in view of Bredoux *et al.*

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In view of the foregoing remarks and the amendment above, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicant also invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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